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U.S. SERIAL NO. 09/448,508
PATENT

REMARKS

Claims 1-10 and 12-30 are pending in the application.

Claims 1-10 and 12-30 have been rejected.

No claims have been amended.

I. REJECTION UNDER 35 U.S.C. § 102

Claims 1-3, 5, 18-19, 24-25, and 30 were been rejected under 35 U.S.C. § 102(b) as being anticipated by Kosaka, et al. (US 5,220,629). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Though Kosaka recites that "[apparently the start of a word or sentence] can be determined by the number of morae representing a syllable in the sentence or word, and the order of the mora having the highest power in the series," (Col. 8, lines 40-45), it appears, that the morae count is then used to set accent or power during speech synthesis of various consonant-vowel (CV), vowel-consonant-vowel (VCV), or consonant-vowel-consonant (CVC) phonemes. Kosaka recites a "parameter expansion/reduction rate setting means" for setting an

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"expansion/reduction rate" for VCV parameters. Col. 12, lines 55-59. The expansion/reduction rate is larger for a vowel, the letter "S," and the letter "F" and smaller for explosive consonants such as "P" and "T." Col. 12, lines 59-64. The parameters are expanded or reduced to coincide with a "syllable beat point pitch," where the syllable beat point pitch is determined using a method described with reference to Figure 19 of Kosaka. Col. 13, lines 1-10.

Importantly, independent claims 1, 18 and 24 also recite assigning a playing rate indicator to each word in a segment based on the syllable count for the respective word. Such a feature is not disclosed in Kosaka. The Office Action argues Kosaka anticipates assigning a playing rate indicator to words based on the total number of syllables in the words by reciting that VCV parameters are expanded or reduced to coincide with syllable beat point pitches. See, Office Action, page 2.

The Office Action fails to show that the morae count (representing the syllable count) that is used by Kosaka to determine the power of a word or sentence is later used to expand or reduce a playing rate assigned to each word. As such, Kosaka fails to assign a playing rate to a word based upon the number of syllables in a word. The basis for the current rejection appears to be that Kosaka discloses counting syllables and expanding or reducing VCV parameters. However, Kosaka fails to disclose that the second function (assigning a playing rate indicator for each word based upon the number of syllables in that word) is based on the results of the first function. Because of this, the Office Action fails to show that Kosaka anticipates counting "syllables in each word of [a] text segment" and assigning a "playing rate indicator"

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to each word "based on a total number of syllables in said word" as recited in Claims 1, 18, and 24. Thus, Kosaka fails to disclose that the playing rate for a particular word (text-to-speech conversion) is based upon the number of syllables in that word.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1-3, 5, 18-19, 24-25, and 30.

II. REJECTION UNDER 35 U.S.C. § 103

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Kosaka, et al. (US 5,220,629) in view of Hutchins (US 5,384,893).

Claims 6-7, 20-21, and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oikawa et al. (US 5,396,577) in view of Church (US 5,146,405). Claims 8-10 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oikawa and Church, in further view of Hutchins.

Claims 13-14, 22-23, and 28-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Oikawa* in view of Richard, et al. (US. 5,924,068). Claims 15-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oikawa and Richard, in further view of Hutchins.

These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262,

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23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the

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prior art, and not based on applicant's disclosure. MPEP § 2142.

With respect to Claim 4 (dependent on Claim 1), for the same reasons set forth above in response to the Section 102 rejection of Claim 1, Kosaka and Hutchins fails to disclose, teach or suggest the Applicant's invention in Claim 4.

With respect to Claims 6-7, 20-21, and 26-27, Oikawa recites a speech synthesizing apparatus. The apparatus associates portions of original text with "importance degree information." The importance degree information identifies the importance of each portion of the original text. Based on the speed at which the original text is to be read, a portion of the original text may be skipped depending on the importance degree information for that portion. See, Oikawa, Abstract.

Though Oikawa recites associating an importance degree value with each portion of original text, the reference fails to disclose, teach, or suggest associating an importance degree value with each word in the original text. As a result, Oikawa fails to disclose, teach, or suggest assigning a playing rate indicator to "each word" of a text segment as recited in independent Claims 6, 20, and 26.

In addition, the importance degree values of Oikawa do not identify a rate at which a portion of text is played. Instead, the importance degree values allow Oikawa to skip portions of text. As a result, Oikawa fails to disclose, teach, or suggest assigning a "playing rate indicator" to each word of a text segment as recited in independent Claims 6, 20, and 26.

The Office Action cites Church only as disclosing analysis of text to identify "parts of

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speech," which are then used to synthesize speech. See, Office Action, page 6. The Office Action does not rely on Church as disclosing, teaching, or suggesting assigning a "playing rate indicator" to "each word" of a "text segment based on said grammatical analysis" as recited in independent Claims 6, 20, and 26.

For these reasons, the Office Action has failed to show that the proposed Oikawa-Church combination discloses, teaches, or suggests all elements of Claims 6, 20, and 26. As a result, the Office Action has failed to establish a *prima facie* case of obviousness against independent Claims 6, 20, and 26 (and their dependent claims).¹

With respect to Claims 13-14, 22-23 and 28-29, these claims recite comparing "each word of [a] text segment to an inventory of pre-selected words" and assigning a "playing rate indicator" to each word "based on said comparison." The Office Action acknowledges that Oikawa fails to disclose assigning a "playing rate indicator" to "each word" of a "text segment" based on a comparison of each word to "an inventory of pre-selected words." Office Action, page 9. In fact, Oikawa fails to disclose, teach, or suggest assigning a playing rate indicator to each word of a text segment on any basis. As described above, the importance degree values of Oikawa allow the apparatus of Oikawa to skip portions of text and do not actually identify a rate at which a portion of text is played. As a result, Oikawa fails to disclose assigning a "playing rate indicator" to each word of a text segment, as recited in Claims 13-14, 22-23, and

¹ With respect to Claims 8-10 and 12 (depending on independent Claim 6), the Hutchins reference fails to cure the deficiencies of the Oikawa-Church combination.

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28-29.

In addition, there is no motivation for modifying Oikawa with the disclosure of Richard. Richard recites an apparatus for reading newspaper articles to a user. The apparatus receives dictionary addresses representing words in a dictionary, and the apparatus accesses the dictionary and reads the words at those addresses to the user. The user can control the rate at which the articles are read and provide keywords that are used to select which articles are read. Richard, Abstract.

The Office Action argues that a person would combine Oikawa and Richard because it would allow "system users to determine what text is synthesized and vary the rate at which the synthetic speech is produced." Office Action, page 9. The cited portion of Richard recites that keywords are used to select newspaper articles and a dictionary is used to locate and read words in the articles to a user. This cited portion fails to disclose that the dictionary or keywords are used to "vary the rate at which the synthetic speech is produced." Also, the cited portion fails to recite that the dictionary is used to determine "what text is synthesized."

For these reasons, the Office Action has failed to establish that a person skilled in the art would combine Oikawa and Richard. Further, the proposed Oikawa-Richard combination fails to disclose, teach, or suggest all elements of Claims 13, 22, and 28. As a result, the Office Action has failed to establish a *prima facie* case of obviousness against Claims 13-14, 22-23, and

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28-29.² (and their dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejections of Claims 4, 6-10, 13-17, 20-23 and 26-29.

III. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

² With respect to Claims 15-17 (depending on independent Claim 13), the Hutchins reference fails to cure the deficiencies of the Oikawa-Richard combination.

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If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at rmccutcheon@davismunck.com.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

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